

## REMARKS/ARGUMENTS

The following remarks and arguments are in response to the Office Action mailed December 30, 2004.

The Examiner's withdrawal of the double patenting rejections and the art rejections over Courtoy, et al. is gratefully acknowledged.

### **Claim Rejections – 35 U.S.C. §112**

Claims 33, 47, 50, 51, 54 and 56-58 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The rejection alleges that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors at the time the application was filed had possession of the claimed invention. The rejection states further that the claims recite the portion of the cured layer coating disposed over the optional second ink is chemically embossed; however, the recitation is not fully supported in the present specification and nowhere in the specification discloses that the cured layer over the first ink is chemically embossed.

By way of background, applicants respectfully direct the Examiner's attention to paragraphs [0028] and [0034] wherein applicants have explained that various kinds and combinations of inks can be used to carry out the invention. The terms "first ink," "second ink," "third ink" and the like are used for convenience but each time they are used in a claim or in the specification they are defined in context and used consistently in that context.

Regarding the optional second ink in the rejected claims, the term "second ink" is consistently defined as containing an inhibitor. One skilled in the relevant art knows that an inhibitor ink is used to create chemical embossing. The specification describes chemical embossing using an inhibitor ink, for example, in paragraph 5, lines 23 and 24 which bridge pages 3 and 4 of the specification the applicants explain, "those portions of the gelled plastic layer which do not contain the inhibitor applied with the second printing ink, foam and expand." This is the classic definition of chemical embossing and clearly describes chemical embossing with an inhibitor ink which is defined in the context of the foregoing passage as a second printing ink.

Another passage in the specification which describes chemical embossing by means of the inhibitor in the second printing ink is paragraph [0046].

The Examiner notes that nowhere in the specification discloses that the cured layer over the first ink is chemically embossed. This is correct in the context of the definition of the first ink in the rejected claims as an ink containing a photoinitiator. The photoinitiator does not cause chemical embossing. If an ink contains both a photoinitiator and an inhibitor, the chemical embossing is caused by the inhibitor and not the photoinitiator.

In light of the foregoing, withdrawal of the rejection under the first paragraph of 35 U.S.C. §112 is respectfully requested.

#### **Claim Rejections – 35 U.S.C. §102**

Claims 33, 47,50-52, 54 and 56-58 have been rejected under 35 U.S.C. §102(e) as being anticipated by Grossman, et al. (U.S. Patent No. 6,613,256) as evidenced by

Eby, et al. (U.S. Patent No. 5,961,903). In making the rejection, the Examiner notes that the second ink and the third ink are not required by the claims and, therefore, any limitations associated with them are completely excluded from the claims. However, applicants respectfully point out that the first ink is a required element of the claims and it must contain a photoinitiator. None of the inks in Grossman contain a photoinitiator and there is no teaching or suggestion in Grossman or Eby of the use of a photoinitiator.

Grossman uses an entirely different method and construction from that of applicants' invention. The reference describes a temperature gradient technique such that there is a temperature difference between the foamed and non-foamed regions which permits a selective mechanical embossing effect. The inks used in Grossman include either inhibitors, retarders, activators or accelerators. They do not include photoinitiators.

In light of the foregoing, Grossman cannot anticipate or render obvious the presently claimed invention and the rejection should be withdrawn.

### **CONCLUSION**

The instant application is believed to be in condition for allowance. A Notice of Allowance of claims 33, 47, 50-52, 54 and 56-58 is respectfully requested. The Examiner is invited to telephone the undersigned at (908) 722-0700 if it is believed that further discussions, and/or additional amendment would help to advance the prosecution of the instant application.

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of this Response to Final Action requires an extension of time, applicant respectfully requests that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,  
NORRIS McLAUGHLIN & MARCUS, P.A.

By   
William R. Robinson  
Attorney for Applicant  
Reg. No. 27,224  
NORRIS, McLAUGHLIN & MARCUS  
P.O. Box 1018  
Somerville, NJ 08876-1018  
Phone: (908) 722-0700  
Fax: (908) 722-0755

Date: March 2, 2005